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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418
20995 7590 06/03/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
06/03/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 10-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 10-12, 14, 15, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. In view of the pre-brief appeal conference decision, the previous Office action has been withdrawn. Claims 8, 10-12, 14, 15, 19 and 20 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to applicants' remarks filed 3/17/2009, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Specification

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the specification throughout contains numerous words with incomplete spelling. For example, in page 7, bottom paragraph, the terms "surface" are misspelled as "surfa e" or "surfa", the term "protective" is misspelled as "prot tive", the term "function" is misspelled as "fun tion", the term "other" is misspelled as "ther", and the term "thickness" is misspelled as "thi kness", etc. Appropriate corrections of the spelling errors throughout the specification are required in the next reply to avoid being held as nonresponsive.

Rejections Based on Prior Art

5. Claims 8, 10-12, 14, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-151360 [computer translation] in view of Masuda [US 20020064650A1].

JP '360 relates to a transparent surface protecting film which maintains a high transparency even if it is used over the long period of time, and has an antistatic effect [0028]. The film comprises a tacky (adhesive) layer on one surface of a transparent base material and an antistatic layer on the other surface [abstract]. Examples of base films include polyester, polycarbonate films, etc. [0008]. Examples of adhesive include acrylic pressure sensitive adhesive, etc. The adhesive layer thickness is 1-10 μ m [0011].

For claims 8, 10-12, 14, 15 and 20, JP '360 lacks teachings of the composition of the polyester film, and the use of an antistatic layer of a polymer comprising a main chain having pyrrolidinium ring containing repeating units. However, Masuda's invention relates to a protective film. The film comprises a polyester film having on at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than $1.0 \times 10^{13} \Omega$, and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent) [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings [0031]. Examples of useful polyesters include polyethylene terephthalate (PET), etc. [0017]. It would have been obvious selection to one of ordinary skill in the art to use PET to form the polyester film and the as the polymers having a backbone containing repeating units of pyrrolidinium rings, as taught by Masuda, to make the protecting film of JP '360, because the selection of a known material based on its suitability for

its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. The collective teachings of prior art render the structure and composition of the claimed invention obvious. Regarding the transparency after a prolonged period of heat treatment, it is deemed to be inherent to the same chemistry as the claimed invention. Regarding the use language in the preamble, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

For claim 19, JP '360 teaches the use of an adhesive comprising acrylic ester copolymer [0026]. The ester group is inherently formed from monomers containing carboxyl groups and hydroxyl groups. Regarding the weight percentages of the monomers, since Masuda teaches the same adhesive composition for the same end use as the claimed invention, workable amounts of monomers in the acrylic ester copolymer are deemed to be obviously provided by practicing the invention of prior art for the same end use.

Response to Arguments

6. Applicants' arguments directed to withdrawn grounds of rejections are moot.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794